

### **REMARKS/ARGUMENTS**

The rejections presented in the Office action dated March 31, 2004 have been considered. Claims 1-39 remain pending in the application. Claims 1, 21, 24, 36, 38 and 39 have been amended. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

In connection with the Examiner's reconsideration of this case, the undersigned attorney of record kindly requests an interview with the Examiner if the rejections are maintained. While the instant RCE and response is being filed in an effort to facilitate prosecution of this application and advance the case to allowance, it is believed that the case is allowable in view of the cited art and current rejections, and the undersigned attorney kindly requests discussing this with the Examiner if the rejections are maintained.

The Applicant first notes from the Advisory Action dated August 17, 2004 that Claim 37 has been allowed, and Claim 36 has been objected to. The Applicant thanks the Examiner for favorable consideration of Claim 37. Claim 36 has been rewritten in independent form to overcome the objection. Claim 36 has been amended only to rewrite the claim in independent format, and it is not intended to limit the scope of Claim 36 as originally filed.

Claims 1, 8-24, 27-29, 33-35, 38 and 39 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,615,038 to Moles et al. (hereinafter *Moles*). The Applicant respectfully submits that *Moles* does not anticipate these claims as pending, and kindly requests reconsideration and allowance of these claims.

*Moles* is directed to a system for automatically gathering configuration data associated with mobile stations. A database is provided to create/store mobile station configuration records, and an update controller is used to update configuration data on the mobile station (*e.g.*, col. 3, lines 4-15, 33-36). The update controller can periodically poll mobile station manufacturers for upgrade information, and send update alert messages to mobile stations (*e.g.*, col. 7, lines 40-48).

According to *Moles*, service provisioning is carried out in a traditional manner, and mobile station configuration data can be updated during or after the service provisioning

process. More particularly, when an unprovisioned mobile station accesses the network, the Base Station (BS) 101 and/or Mobile Switching Center (MSC) 140, using the handset data in the Home Location Register (HLR) 155, performs an over-the-air (OTA) service provisioning of the mobile station (col. 6, lines 28-33). Service provisioning is carried out using a provisioning server, as noted by *Moles* at column 6, lines 40-42 where it indicates that the HLR 155 stores a minimum amount of data to authenticate the mobile station and to establish a connection to the provisioning server. Either during provisioning or subsequently, a mobile station configuration server 160 gathers configuration data from the mobile station and stores it in a configuration record in a database, where this configuration server 160 is thereafter used to transmit mobile station updates to the mobile station (col. 6, lines 33-39). Therefore, *Moles* describes a system using a provisioning server to initially provision a terminal, and further describes a second system (the mobile station configuration server 160) to assist in performing data or software updates to the particular mobile devices.

Claim 1 has been amended to clarify that the provisioning Web service is implemented using “Web Services.” *Moles* does not teach or otherwise describe any use of Web Services. As previously set forth by the Applicant, a Web Service generally refers to a network-based modular application(s) that perform a specific task(s) and conform to a particular technical format. Web Services are self-contained modular applications that can be published in a ready-to-use format, located, and invoked across the World Wide Web. When a Web service is deployed, other applications and Web services can locate and invoke the deployed service. (See, *e.g.*, page 10, lines 10-21). By using a Web Services interface to the functionality, the applications and services can use the client provisioning capabilities without having knowledge of the underlying mobile technologies.

Because a rejection of anticipation requires that the cited reference teach all claim recitations, and because *Moles* does not, *Moles* cannot anticipate pending Claim 1. More particularly, in the prior Office action, column 1, line 52 through column 2, line 13 of *Moles* is identified as teaching a “provisioning Web service.” The Applicant respectfully disagrees, as the cited portion of *Moles* merely describes conventional “service provisioning,” which is stated to be an OTA process that activates in the cellular handset a

Number Assignment Module (NAM), Preferred Roaming List (PRL), and an A-key. As seen from the paragraph immediately preceding the Examiner's cited portion, the described "service provisioning" involves the subscriber calling a special telephone number such as "\*288xx" where "xx" is a unique number for each wireless service provider, which causes the new subscriber to connect to an operator (col. 1, lines 54-57). The operator then collects information, such as the subscriber's name, address, credit card information, and type of service desired (col. 1, lines 57-60). When the account information is collected and the account established, the operator instructs the handset buyer to manually enter several sequences of passwords, code numbers and menu-selected commands that enable certain functions in the handset. It is this procedure that *Moles* refers to as "service provisioning," which does not describe a provisioning Web service, which is implemented using Web Services, that serves as an interface between the mobile terminal(s) and the network service(s) as set forth in Claim 1. Thus, *Moles* fails to teach any provisioning beyond traditional provisioning techniques, and fails to anticipate Claim 1.

Further, the Applicant continues to maintain that *Moles* fails to teach any entity that provides a single point of interface in which network services may contact in order to provision the mobile terminal. The Office Action cites a browser interface used between a user and the mobile terminal as reading on a Web service interface providing a single point of interface to the network service for provisioning the mobile terminal. The Office Action identifies column 1, lines 41-44 of *Moles* as teaching this recited feature, which states:

For instance, a 3G cell phone (or a PC with a 3G wireless modem) may be used to browse web sites on the Internet, to transmit and receive graphics, to execute streaming audio and/or video applications, and the like.

This recited portion of *Moles* merely indicates that a mobile station user can browse web sites. The Applicant respectfully contends that this does not even address the particular interface that is being claimed - the interface between the provisioning Web service and the network services. The cited portion of *Moles* is directed to an interface between a person using the mobile terminal, and the mobile terminal. As set forth in Applicant's Specification, page 4, lines 7-10, one of the prior art deficiencies addressed by the present

invention is to alleviate the problem of multiple interfaces as seen by the network service providing the application. As stated on page 27, lines 9-12 of the Specification:

More particularly, the provisioning Web service interfaces 706 the mobile terminal(s) and the network service(s). In the illustrated embodiment, the provisioning Web service serves as a single point of interface for the network service(s) to provision the requesting mobile terminals. (emphasis added)

Thus, different network services wanting to provision mobile terminals can look to a single place - the provisioning Web service - in order to provision mobile terminals. This is markedly different from the user interface that a browser application provides on a mobile station. It is respectfully submitted that this is not taught or otherwise described in *Moles*, and for this additional reason *Moles* fails to anticipate Claim 1.

Further, in paragraphs 26 and 27 of the final Office action, the Examiner further asserts that in addition to the browser interface, *Moles* teaches a provisioning web service that provides a single point of interface to network services, arguing that *Moles* discloses a wireless service provider (reference 150 of FIG. 1), and that this is a single point of interface that provides users with direct access to the IP communications network. It is respectfully submitted that the identified wireless service provider in *Moles* fails to anticipate the claims as is suggested in the Office Action.

More particularly, the single point of interface refers to an interface as seen by the network service. It is respectfully submitted that the rationale set forth in the final Office action inappropriately focuses on an interface between a mobile device and a server. Claim 1, for example, recites that the provisioning Web service provides a single point of interface for the network service, and thus the single point of interface is from the point of view of the network service, not the mobile terminal. A service provider (i.e., a network service) sees the provisioning Web service as a single point of interface in order to provision mobile terminals. It is the network service(s) that sees the Web service as a single point of interface in order to provision the mobile terminal(s). In other words, when a network service wants to provision a mobile terminal, it need not locate multiple entities or services, but rather need only make use of the provisioning Web service in order to carry out the desired mobile terminal provisioning. This is not taught by *Moles*, and is not taught by the

recited portion of *Moles* (reference 150, FIG. 1) regarding a wireless service provider that provides users with direct access to the IP communication network. The IWF 150 of *Moles* referred to in the final Office action is an “interworking function (IWF) that is a component of the wireless network used for translating protocols, and not for provisioning mobile terminals (see *Moles*, column 6, lines 10-27).

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicants respectfully submit that *Moles* fails to teach at least the claimed features mentioned above, and therefore fails to teach every element of Claim 1. Therefore, Claim 1 is not anticipated by *Moles*.

Independent Claims 21, 24, 38 and 39 were rejected on the same grounds as Claim 1. Claims 21, 24, 38 and 39 have been amended analogously to that of Claim 1, and the arguments above for Claim 1 are also applicable to Claims 21, 24, 38 and 39 in that it is respectfully submitted that *Moles* fails to teach at least a provisioning Web service implemented using Web Services and a provisioning Web service that serves as a single point of interface for the network services. For at least these reasons, it is respectfully submitted that *Moles* fails to anticipate Claims 21, 24, 38 and 39, and Claims 21, 24, 38 and 39 are therefore in condition for allowance.

Further, with respect to independent Claim 21, the rationale for rejecting Claim 21 is stated to be “the same reasons set forth in claims above,” and that *Moles* discloses a Web service data object delivery module. Notwithstanding that the Applicants do not acquiesce that *Moles* describes a Web service data object delivery module, the Office action is silent with respect to the Web service mobile terminal configuration module claimed in Claim 21, and no corresponding feature has been identified in *Moles* as reading on such claim recitation. The Applicant contends that *Moles* does not teach a configuration module, particularly a Web services configuration module, that is used to configure the mobile terminal for use of applications provided by the network service providers. *Moles* describes

providing upgrades to mobile stations, but does not teach any such module to configure a mobile device for use of an application(s) hosted or otherwise provided by a network service provider. For at least this additional reason, the Applicant respectfully submits that Claim 21 is not anticipated by *Moles*.

Dependent Claims 8-20 are dependent from independent Claim 1, dependent Claims 22-23 are dependent from independent Claim 21, and dependent Claims 27-29 and 33-35 are dependent from independent Claim 24. Each of these dependent claims were also rejected under 35 U.S.C. §102(e) as being unpatentable over *Moles*. While the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent Claims 1, 21 and 24. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 8-20, 22-23, 27-29 and 33-35 are also in condition for allowance.

Claims 2-7, 25-26, and 30-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moles* as applied to Claims 1, 8-24, 27-29, 33-35, and 38-39, in further view of Scott Seely “Web Service description and Discovery Using UDDI, Part II”, Microsoft Corporation (hereinafter *Seely*). The Applicant respectfully traverses the Examiner’s rejection.

The Applicant respectfully contends that *prima facie* obviousness has not been established based on the combination of references of *Moles* and *Seely* under 35 U.S.C. §103(a), particularly in view of the amendments made herein. To establish a *prima facie* case of obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143. There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; there must be a reasonable expectation of success; and the prior art references must teach or suggest all of the claim limitations. It is respectfully submitted that the *prima facie* case of obviousness necessarily fails as the prior art references fail to teach or suggest all claim limitations, and further there is no suggestion or motivation to combine the reference teachings.

The Applicant respectfully contends that *Moles* fails to teach the claimed subject matter that is allegedly taught by *Moles*. Dependent Claims 2-7 are directly or indirectly dependent from independent Claim 1, and dependent Claims 25, 26, and 30-32 are directly or indirectly dependent from independent Claim 24. In rejecting these dependent claims, it is recognized in the Office Action that *Moles* is relied upon as teaching the claimed elements from their respective independent claims. As stated above, the Applicant respectfully submits that *Moles* fails to teach various features of these respective independent claims. *Seely* fails to remedy this deficiency, and therefore neither *Moles* nor *Seely*, either alone or in combination, teach all of the elements of the dependent claims which necessarily include the features claimed in their respective independent claims.

With respect to dependent Claims 2 and 3, it is acknowledged in the Office Action that *Moles* fails to disclose all of the text of dependent Claim 2. As previously indicated, *Moles* also fails to teach or suggest at least a provisioning Web service that provides a single point of interface for the network service for provisioning the mobile terminal. *Seely* also fails to teach at least this claimed feature of Claim 2. Therefore, neither *Moles* nor *Seely*, either alone or in combination, teach or suggest all the limitations of Claim 2 as required to establish *prima facie* obviousness. For at least this reason, Claim 2 is in condition for allowance.

Claim 3 is indirectly dependent from Claim 1, and therefore also includes claimed features not taught or suggested by *Moles*, *Seely*, or a combination thereof. Further, while the Examiner rejected Claim 3, nothing in *Moles* or *Seely* has been identified that teaches or suggests parsing requests or generating responses thereto. For at least this additional reason, *prima facie* obviousness has not been established with respect to Claim 3.

It is also noted that there must be some actual *motivation* to combine *Moles* and *Seely* found in the references themselves or the knowledge of one of ordinary skill in the art that would suggest the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). *Moles* fails to address Web services in any form, and *Seely* fails to discuss provisioning. Therefore, there is no motivation to combine

such references found in the references themselves. The proffered motivation thus appears to rest on the statement that one of ordinary skill in the art would combine such references to “allow users to receive the desired network resources” (see Detailed Action, paragraph 17). However, it is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.* The examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching in *Moles* that leads “to the combination” of *Moles* with *Seely* or vice-versa. It is respectfully submitted that the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through impermissible hindsight. As stated by the Federal Circuit:

“Combining prior art references without evidence of such a suggestion, teaching, or motivation **simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.**”

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added).

It is respectfully contended that the rationale for motivating one to combine *Moles* and *Seely* of allowing users to receive the desired network resources falls short of the mandate for establishing *prima facie* obviousness. For at least this additional reason, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness, and dependent Claims 2-3 are allowable over the cited prior art. The Examiner rejected dependent Claims 5, 25 and 26 for the same reasons, and the Applicant contends that the aforementioned arguments equally apply to Claims 5, 25 and 26.

With respect to dependent Claims 4, 6 and 7, it is acknowledged in the Office action that *Moles* fails to disclose SOAP, UDDI, and WSDL. Claim 4 indicates that parsing requests and generating responses thereto includes implementing SOAP for parsing the requests and generating the responses. The cited portion of *Seely* relied upon in the Office action as implementing SOAP for parsing requests and generating responses is on page 8 of



*Seely*, which merely states “[n]ext time, we will have a guest column from Allen Wagner. Allen will be discussing techniques for handling large SOAP messages.” Page 8 also identifies a book having a title including the word “SOAP” and that the author wrote and maintains a small SOAP library. The Applicant respectfully submits that this clearly fails to teach using SOAP to parse requests from Web service modules within a provisioning Web service and network service and to generate responses thereto. The Applicant respectfully submits that *prima facie* obviousness has not been established for Claim 4.

It is further noted that the language of Claim 7 has not been addressed, although Claim 7 was also rejected by the Examiner. To establish *prima facie* obviousness, the Examiner must identify corresponding teachings/suggestions in the cited art that teaches enabling the application to initiate requests to provision the mobile terminals via the Web service endpoint. For at least this reason, *prima facie* obviousness has not been established with respect to Claim 7.

The stated motivation for combining these references as they apply to Claims 4, 6 and 7 is that “SOAP is known as a XML based protocol (i.e., communication protocol) that provides the Internet Web service.” First, the Applicant respectfully contends that this alleged motivation is merely a statement of what SOAP is, and not why *Moles* and *Seely* could or should be *combined*. Further, this stated motivation does not address Claims 6 or 7 at all. For at least these additional reasons, *prima facie* obviousness has not been established for Claims 4, 6 and 7.

Dependent Claim 31 is ultimately dependent from independent 24, and as previously indicated *Moles* fails to teach or suggest at least a provisioning Web service that provides a single point of interface for the network service. *Seely* also fails to teach at least this claimed feature, and therefore neither *Moles* nor *Seely*, either alone or in combination, teach or suggest all the limitations of Claim 31 as required to establish *prima facie* obviousness. For at least this reason, Claim 31 is in condition for allowance.

Claims 30 and 32 stand rejected for the same reasons as set forth in Claim 37. However, Claim 37 has now been allowed by the Examiner, and thus Claims 30 and 32 would appear to be in condition for allowance.

The undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

Respectfully submitted,

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